



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS, MI 48304-0610

COPY MAILED

FEB 25 2005

| | | |
|----------------------------------|---|----------------------------|
| In re Application of | : | OFFICE OF PETITIONS |
| Michael Farmer and Xunchang Chen | : | |
| Application No. 10/625,208 | : | DECISION ON PETITION |
| Filed: July 23, 2003 | : | |
| Attorney Docket No. 65858-0021 | : | |
| Title: SYSTEM OR METHOD FOR | : | |
| CLASSIFYING IMAGES | : | |

This is in response to the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) and PETITION PURSUANT TO 37 CFR 1.47 INVOLVING THE REFUSAL OF CO-INVENTORS TO EXECUTE THE POWER OF ATTORNEY both filed December 21, 2004.

The petition under 1.47 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b) and 1.47." As to meeting the requirements of § 1.47(b), the petition should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors.

A decision on the petition under 1.137(b) is being held in abeyance pending satisfaction of the requirements under 1.47.

The above-identified application became abandoned for failure to reply to the Notice to File Missing Parts of Application mailed December 1, 2003. The Notice set a period for reply of two (2) months from the mail date of the Notice, with extensions of time obtainable under 37 CFR 1.136(a). No reply having been timely received and no extensions of time obtained, the above-identified application became abandoned on February 2, 2004. A courtesy Notice of Abandonment was mailed on October 21, 2004.

In response, the instant petition was filed. The petition fee has been charged to Deposit Account No. 18-0013, as authorized. Petitioner asks to make application as agent for and on behalf of Eaton Corporation who employed inventors Farmer and Chen at the time of the filing of the application. Petitioner asserts that diligent effort have been made to provide the non-signing inventors with the necessary documents. The petition includes an unexecuted declaration, the late surcharge, and an unexecuted assignment.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to 37 CFR 1.137(d).

Petitioner seeks to satisfy § 1.137(b) by way of submission of a declaration accepted pursuant to 37 CFR 1.47(b).

37 CFR 1.47(b) provides that:

Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(h), and the last known address of

all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

Accordingly, a grantable petition under 37 CFR §1.47(b) requires: (1) an acceptable oath or declaration in compliance with 37 C.F.R. §1.63 and 1.64 or 1.175; (2) the rule 47 applicant must state his or her relationship to the inventor as required by 37 C.F.R. §1.64; (3) proof that the non-signing inventor cannot be found or reached after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (4) the petition fee; (5) a statement of the last known address of the non-signing inventor; (6) that rule 47 applicant make out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the invention; and (7) rule 47 applicant must prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage. See MPEP §409.03(g).

See 35 U.S.C. §118; 37 C.F.R. §1.47; §§409.03 and 605 of the Manual of Patent Examining Procedure (8th ed) (Rev. 2, May 2004) (MPEP).

The petition and declaration have been reviewed and found to satisfy requirements (3) and (4) above. Petitioner has provided evidence to show that the application papers were presented to the inventors; however, by their conduct in not responding, they have refused to join in the application. The petition fee has been charged to Deposit Account No. 18-0013, as authorized.

However, the petition does not satisfy requirements (1), (2), (5), (6) and (7) above:

As to requirements (1) and (2), petitioner has submitted an unexecuted declaration. Further, in addition to not being signed, the declaration does not contemplate execution by rule 47(b) applicant on behalf of the non-signing inventors.

Petitioner is advised that the 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person,

including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP §324.

As to requirement (5), the petition does not include a statement of the last known addresses of the non-signing inventors. The declaration includes addresses, but will not be relied on as it is unacceptable (and unexecuted).

As to requirement (6), rule 47(b) applicant states that the inventors were employees of rule 47(b) applicant. However, in support of a proprietary interest, petitioners only submit an unexecuted assignment. Thus, it cannot be concluded that rule 47 applicant has made out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the invention. Petitioner's attention is directed to MPEP 409.03(f) for guidance on showing proof of proprietary interest.

As to requirement (7), petitioner has not addressed this requirement. The petition does not include a statement that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage. See MPEP §409.03(g).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By fax: (703) 872-9306
ATTN: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions